APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,254	04/27/2005	Andrew Dominic Tune	17480P030	8752

8791   7590   12/16/2008
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EXAMINER
REVAK, CHRISTOPHER A

ART UNIT	PAPER NUMBER
2431	

MAIL DATE	DELIVERY MODE
12/16/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/511,254	TUNE, ANDREW DOMINIC
	Examiner	Art Unit	
	Christopher A. Revak	2431	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 October 2004</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-26</u> is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-26</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on <u>08 October 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a)☒ All   b)☐ Some * c)☐ None of:
      1.☒ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☒ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date <u>11/23/04; 4/23/08</u>.
4)☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Priority

1.   Acknowledgment is made of applicant's claim for foreign priority under 35

U.S.C. 119(a)-(d).

Information Disclosure Statement

2.   The information disclosure statements (IDS) submitted are in compliance with the

provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being

considered by the examiner.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

4.   Claims 6-9 and 24 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter and do not falling within one of the

four statutory categories of invention. While the claims recite a series of steps or acts to

be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to particular

machine, or (2) transform underlying subject matter (such as an article or material) to a

different state or thing. See page 10 of In Re Bilski 88 USPQ2d 1385. The instant

claims are neither positively tied to a particular machine that accomplishes the claimed

method steps nor transform underlying subject matter, and therefore do not qualify as a

statutory process. Dependent claims 10 and 11 implement hardware elements tied to

the process which meet the criteria defined in the decision of In Re Bilski 88 USPQ2d

1385.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

6.   Claims 20 and 24 rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the enablement requirement. The claims contains subject matter which

was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the

invention. The claims recite of discarding information, however the specification fails to

further describe the process of discarding information and how it is used in combination

with the process of generating information from first and second data.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public
> use or on sale in this country, more than one year prior to the date of application for patent in the United
> States.

8.   Claims 1-8,10-12,15-19,22,23,25, and 26 are rejected under 35 U.S.C. 102(b) as

being anticipated by Sandberg-Diment, U.S. Patent 5,826,245.

As per claim 1, it is disclosed of a system for storing information having a
predetermined use which requires said information to be secured, including; a client
system for generating first data and second data from said information, such that said
information can be generated from said first data and said second data, and said
predetermined use is infeasible with only one of said first data and said second data,
and for storing an identifier with said first data; and a remote server for storing said
second data with an encoded identifier generated from said identifier (col. 2, lines 32-56
& 60-67).

As per claim 2, it is taught wherein said remote server is adapted to send an
encoded version of said second data to said client system, and said client system is
adapted to generate an encoded version of said information from said first data and said
encoded second data, and to store the encoded information with said identifier (col. 2,
lines 32-56 & 60-67).

As per claim 3, it is disclosed of including a remote hash server for generating
the encoded second data (col. 2, lines 32-56 & 60-67).

As per claim 4, it is taught of a system for storing information having a
predetermined use which requires said information to be secured, including: a client
system for storing an encoded version of said information and an identifier, the encoded
information having been generated from first data of said information and an encoded
version of second data of said information, wherein said information can be generated
from said first data and said second data, and said predetermined use is infeasible with
only one of said first data and said second data; and a remote server for storing said

second data and an encoded identifier generated from said identifier; wherein said client

system is adapted to send at least the encoded version of the second data to said

remote server (col. 2, lines 32-56 & 60-67).

As per claim 5, it is disclosed of including a plurality of said remote server, and a

gateway for selecting at least one of the remote servers, and for forwarding data

received from said client system to the selected at least one remote server (col. 2, lines

32-56 & 60-67).

As per claim 6, it is taught of a process for storing information having a

predetermined use which requires said information to be secured, including generating

first data and second data from said information, such that said information can be

generated from said first data and said second data, and said predetermined use

cannot be performed using only one of said first data and said second data (col. 2, lines

32-56 & 60-67).

As per claim 7, it is disclosed of including generating encoded data from said

information, wherein said first data and second data are generated from said encoded

data (col. 2, lines 32-56 & 60-67).

As per claim 8, it is taught wherein the quantity of said encoded data is

substantially larger than quantity of said information (col. 2, lines 32-56 & 60-67).

As per claim 10, it is taught wherein said first data and said second data are

stored at respective locations physically remote from one another (as shown in Figure

2).

As per claim 11, it is disclosed wherein the process is executed by a client system, and the process includes sending said first data and an identifier to a remote server for storage; and storing said second data and said identifier (col. 2, lines 32-56 & 60-67).

As per claim 12, it is taught wherein an encoded identifier generated from said identifier is stored with said first data (col. 2, lines 32-56 & 60-67).

As per claim 15, it is disclosed of including receiving an encoded version of said first data from said remote server; and generating an encoded version of said information from the encoded first data and said second data; and wherein said step of storing includes storing the encoded information and said identifier (col. 2, lines 32-56 & 60-67).

As per claim 16, it is taught of a process for storing information having a predetermined use which requires said information to be secured, including: receiving an identifier and first data from a client system having second data, said first data and said second data being such that said information can be generated from said first data and said second data, and said predetermined use cannot be performed using only one of said first data and said second data; and storing said first data with an encoded identifier generated from said identifier, without storing said identifier (col. 2, lines 32-56 & 60-67).

As per claim 17, it is disclosed of including generating encoded first data from said first data; and sending said encoded first data to said client system for storage with said second data and said identifier (col. 2, lines 32-56 & 60-67).

As per claim 18, it is taught of a process for generating information having a
predetermined use which requires said information to be secured, including:
determining, on the basis of an identifier, first data of said information; receiving second
data of said information from a remote server; and generating said information from said
first data and said second data, wherein said predetermined use is infeasible with only
one of said first data and said second data (col. 2, lines 32-56 & 60-67).

As per claim 19, it is disclosed of including sending said identifier to said remote
server, and said step of receiving includes receiving, from said remote server, said
second data determined on the basis of an encoded identifier generated from said
identifier (col. 2, lines 32-56 & 60-67).

As per claim 22, it is taught of a process for generating information having a
predetermined use which requires said information to be secured, including: receiving
an identifier; determining first data of said information on the basis of said identifier; and
sending said first data to a client system to enable said information to be generated
from said first data and second data of said information, wherein said predetermined
use is infeasible with only one of said first data and said second data (col. 2, lines 32-56
& 60-67).

As per claim 23, it is disclosed of a process for generating information having a
predetermined use which requires said information to be secured, including;
determining, on the basis of an identifier, an encoded version of said information, the
encoded information having been generated from first data of said information and an
encoded version of second data of said information; and sending said identifier and said

encoded information to a remote server for generation of said information from said first

data and said second data, wherein said predetermined use is infeasible with only one

of said first data and said second data (col. 2, lines 32-56 & 60-67).

As per claim 25, it is disclosed of an information storage system having

components for executing the steps of any one of claims 6-8,10-12,15-19,22, or 23 (col.

2, lines 32-56 & 60-67).

As per claim 26, it is taught of a computer-readable storage medium having

stored thereon program code for executing the steps of any one of claims 6-8,10-12,15-

19,22, or 23 (col. 2, lines 32-56 & 60-67).

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

10.   Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Sandberg-Diment, U.S. Patent 5,826,245 in view of Tavor et al, U.S. Patent 6,070,154.

As per claim 9, it is disclosed by Sandberg-Diment wherein said step of

generating includes encoding said information, however the teachings of Sandberg-

Diment fail to disclose that the information is encrypted. Tavor et al discloses of

encrypting portions of credit card information (col. 8, lines 3-8). It would have been

obvious to a person of ordinary skill in the art at the time of the invention to have been

motivated to encrypt portions of credit card information in order to secure the

information from an unauthorized party. The teachings of Tavor et al recite of

motivational benefits for the use of encrypted portions by disclosing the need for secure

transmission of credit card numbers by breaking the credit card numbers into smaller

portions which are then encrypted for protection and since the information is partitioned,

only receiving the entire transmission will yield the correct credit card number (col. 1,

lines 31-34 & 41-50 and col. 2, lines 29-40). The teachings of Sandberg-Diment

disclose of partitioning credit card information and it is obvious that the teachings of

Tavor et al further secure the transmission by encrypting the transmitted portions.

11.   Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Sandberg-Diment, U.S. Patent 5,826,245.

        As per claims 13 and 14, it is disclosed by Sandberg-Diment of an encoded

identifier, however the teachings fail to disclose of including a cryptographic hash of

said identifier and said hash is remotely generated using a hash function unknown to

said client system and unknown to said remote server. The examiner hereby takes

official notice that the use of hashing functions are notoriously well known. It would

have been obvious to a person of ordinary skill in the art at the time of the invention to

have been motivated to apply a hashing function since they are known as one-way

functions and are irreversible. It is obvious that the hashing of the content would yield a

one way value and if the content was altered in any manner, it would yield a different

hash value. Hash functions can be varied so that only entitled entities are aware of the

correct hash function which is to be applied to content to further enhance the secrecy of the content.

12.   Claims 20,21, and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Sandberg-Diment, U.S. Patent 5,826,245 in view of Wang, U.S. Patent 6,850,916.

        As per claims 20 and 24, it is taught by Sandberg-Diment of a process for generating information having a predetermined use which requires said information to be secured, including receiving an identifier and an encoded version of said information; determining first data of said information on the basis of said identifier; generating said information from said first data and second data of the encoded information, wherein said predetermined use is infeasible with only one of said first data and said second data; using said information for said predetermined use (col. 2, lines 32-56 & 60-67). The teachings of Sandberg-Diment fail to disclose of discarding information. It is taught by Wang of discarding information once a transaction is completed (col. 14, line 66 through col. 15, line 4). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have been motivated to discard information once a transaction has been completed. The teachings of Wang disclose of motivational benefits for discarding of the information by reciting that the card cannot be used again until the authenticated user authorizes the card (col. 15, lines 1-10. It is obvious to a person that the teachings of Sandberg-Diment would have been made more secure by discarding information after a transaction and the card information can not be used again until authorized by an authenticated user, as is taught by Wang.

As per claim 21, it is disclosed by Sandberg-Diment wherein said information includes a credit card number and said predetermined use includes processing a financial transaction on the basis of said credit card number (col. 2, lines 30-37).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Revak whose telephone number is 571-272-3794. The examiner can normally be reached on Monday-Thursday, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher A. Revak/
Primary Examiner, Art Unit 2431